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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,739	11/16/2000	Hongkui Jin	GENENT.68A2D1	7262

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EXAMINER

LANDSMAN, ROBERT S

ART UNIT	PAPER NUMBER
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1647

DATE MAILED: 09/30/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/715,739

Applicant(s)

JIN ET AL.

Examiner

Robert Landsman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-48 and 56-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29,30,32-35,40-48 and 59 is/are allowed.
- 6) ☒ Claim(s) 36 is/are rejected.
- 7) ☒ Claim(s) 31,36-39 and 56-58 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Formal Matters

- A. Amendment B, filed 7/25/03, has been entered into the record.
- B. The Terminal Disclaimer, filed 4/11/03, has been entered into the record.
- C. Claims 29-59 were pending in the application. Claims 49-55 were drawn to a non-elected invention and have been canceled. Therefore, claims 29-48 and 56-59 are pending and are the subject of this Office Action.
- D. All Statutes not found in this Office Action can be found, cited in full, in a previous Office Action.

2. Specification

- A. The objection to the specification has been withdrawn in view of Applicants' amendment to the title.

3. Claim Objections

- A. Claim 31 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 31 recites that the IFN is produced recombinantly. However, it is not known how recombinantly produced IFN differs from non-recombinant IFN since the amino acid sequence for both would be identical regardless of how it is produced.
- B. Claim 36 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 29, from which claim 36 ultimately depends, recites a method of treating a subject who has cardiac hypertrophy. Claim 36 appears to expand this "subject" group by including anyone at risk for cardiac hypertrophy. Even if these populations were different, as may be the case, a population who has hypertrophy would no longer be at risk, since they would actually have the disease.

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C. Claims 56-58 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It is unclear how these claims differ from claim 29 since it seems inherent that a person having cardiac hypertrophy (as recited in claim 29) would have increased levels of PGF2a, given that cardiac hypertrophy generally appears to produce an increase in this compound. Furthermore, it appears that the causes of hypertrophy in claim 29 do not require a virus.

4. Obviousness-Type Double Patenting

A. The rejection to claims 29-48 and 56-59 has been withdrawn in view of Applicants' timely submission of a Terminal Disclaimer over Patent 6,187,304.

5. Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

A. Claim 36 is rejected under 35 U.S.C. 102(e) as being anticipated by Torigoe et al. (U.S. Patent No. 6,207,641). The claim recites a method of treating a patient by administering IFN to a patient at risk of developing cardiac hypertrophy. Torigoe teaches pharmaceutical compositions for treating IFN-related diseases (Example 1). Although the conflicting claims are not identical, they are not patentably distinct from each other because the process steps of administering a IFN are the same regardless of whether or not the purpose is to treat cardiac hypertrophy (Ex parte Novitski, 26 USPQ 1391). Claims 37-39 are objected to since they depend from claim 36.

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6. Conclusions

A. Claims 29, 30, 32-35, 40-48 and 59 are allowable.

Advisory information


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Landsman whose telephone number is (703) 306-3407. The examiner can normally be reached on Monday - Friday from 8:00 AM to 5:00 PM (Eastern time) and alternate Fridays from 8:00 AM to 5:00 PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623.

Official papers filed by fax should be directed to (703) 308-4242. Fax draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Robert Landsman, Ph.D.
Patent Examiner
Group 1600
September 29, 2003


ROBERT LANDSMAN
PATENT EXAMINER